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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,443	09/05/2003	Dan Kikinis	2222.2340002	1634
26111	7590	08/10/2005	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			HARRELL, ROBERT B	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,443

Applicant(s)

KIKINIS, DAN

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached Office Action</u> . |

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1. Claims 1-10 remain for examination.

2. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor. For example, the related United States Patent, mentioned on the first page of this application, is correctly identified as 6,622,169 not 6,662,169; correction is required.

3. The following is a quotation of the second paragraph of 35 U.S.C 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-10 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention because in claim 1, while a server is mentioned, it has no interconnection or activity with the remainder of the system and functions among itself in limbo therefor its function is unclear. Per claim 5, it cannot be clearly ascertained how a specific network itself can configure the general appliance since a network is a set of wires absent logic. The claims recite a "specific network" and a "general network". However, in light of the specification, the only real network is the local telephone network over which is laid the Internet (a logical network). Thus it cannot be clearly ascertained if the specific network and the general network are actually one and the same in construct (i.e., the "Internet" is not a different cable line from the telephone line as would be cable T.V. to the telephone since there is no "Internet" wire from a home to the street per se', the Internet is a Ghost within the Telephone system formulated by a series of protocols among computers using the phone companies as the major means of communication with subnets (i.e., LANs local to the computers) as is FIDOnet or any other set of BBS computers using the telephone lines). That is to say, in light of the specification, the general network (i.e., Internet) is a logical sub-network overlaid the specific telephone network (i.e., POTs PSTN exc...).

5. The following non-statutory double patenting rejections are based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993), In re Berg 140

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F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998), 195 F.3d 1322, 1326, 52 USPQ2d (Fed. Cir. 1999), Eli Lilly CAFC on petition for rehearing En Banc (58 USPQ2d 1869).

6. A timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321 (c) may be used to overcome an actual or provisional rejection based on a non statutory based double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. 3.73(b).

7. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of United States Patent 6,622,169 and/or 6,161,133; these are two distinct rejections as presented on 13 July 2004 which continue and are hereby incorporated in this Office Action by reference. Although the conflicting claims are not word for word identical, they are not patentably distinct from each other because each patent claims contain every element of this instant application and as such anticipates claims of the instant application. That is to say, the claims of this application are broader in scope than the patented claims and thus encompass those patents and more. In this/these instances, one infringing the claims of those patents would be infringing the claims of this instant application. The applicant argued, on 19 May 2005, in his traversals of these rejections by stating in substance that the amendments to claims 1-10 of the instant patent application negate the rationale for the double patenting rejections. Accordingly, the applicant respectfully requests that the examiner reconsider amended claims 1-10 of the instant patent application and remove the rejections of these claims under the judicially created doctrine of obviousness-type double patenting with respect to U.S. Patent No. 6,161,133; and, additionally, the Office Action issued July 13, 2004 (PTO Prosecution File Wrapper Paper No./Mail Date 20040706) (hereinafter "First Office Action") rejected claims 1-10 "under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of United States Patent US 6,622,169 B2." (First Office Action) Because these rejections were not mentioned in the prior Office Action, the applicant assumes that they have been removed. However, the amendments to the claims have not negated the rejections nor has any rejection been removed; to the contrary, more so do the amended claims heighten these rejection and thus the amended claims each still continue in the rejections since their original presentation.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the

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purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

9. Claims 1-10 are rejected under 35 U.S.C. 102 (e) as being anticipated by Giordano, III et al. (United States Patent: 6,370,141 B1).

10. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

11. The grounds for rejection the claims, as presented in examiner prior action(s) with respect to Giordano-U.S. Patent: 6,370,141), continue and are hereby incorporated in this Office Action by reference. The applicant argued, in his 19 May 2005 remarks, that amended independent claim 1 and other independent claims recites, among other things, "a specific network". Giordano does not disclose, teach, or suggest using a specific network to configure a general network appliance to have access to a general network. Consequently, claims 1, 5, and 8 are not anticipated by Giordano. *However*, such a "specific network" was taught in figure 1, which specific network was located between the general network appliance (10, 12, 26, 28) and the server (16, 18, 20, and 22) and those Ethernet/LAN/etc... network wires internal to the server. The simplest network is one wire between two computers. Since such a specific network was shown, as well as another more general network as the Internet, Giordano taught the invention defined in the claims. It is noted that the Internet is a Ghost (more specifically a logical/virtual network) overlaid the POT/PSTN (i.e., local phone company) lines. Furthermore, unless examiner is to read the whole of the specification into claim 5, such would cover an external modem connected to a personal home computer (PC) over a local serial RS-232 link. More specifically, such would be a general network appliance (external modem) which comprised a simple network connection port (any one of the serial and/or COM1-COM4 ports). The modem (i.e., one with a Rockwell chipset) was pre-programmed with a configuration routine to interact, via with a specific network (i.e., the serial RS-232 simple network connection port), to configure the general appliance (modem) to have access to a general real/logical network (i.e., a COST telephone line and/or the Internet). In other words, the CPU box had configuration routines that configured the external modem via the local serial networked RS-232 link such that the modem could dial out over the phone line for computer communication there beyond. This is not an independent rejection since such was anticipated by Giordano's first figure showing a modem, which needed startup (out-of-the-box) configuration. Such also covers all claims 1-10 of this instant application. More over, in Giordano, the Internet Phone was connected to a server that was anticipated to be one of any server that would hold the configuration routines for the Internet Telephone General Appliance.

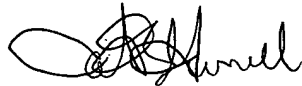
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12. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (703) 872-9306.

15. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142